

REMARKS

The present remarks are in response to the Final Office Action dated March 31, 2005, in which the Examiner rejected claims 1-6, 8-12, and 14-19.

The Applicant has canceled claims 2, 7, 13, 15, and 20 and amended claims 1, 8 and 14. Independent claims 1 and 14 include the feature of claims 2 and 15, respectively, which are now canceled. No new matter has been added.

The Applicant responds to the Examiner's Detailed Action and respectfully requests that all pending claims in the application be placed in a state of allowance.

A. Advisory Action

An Advisory Action dated July 5, 2006, was issued indicating that Applicant's previous response to the office action mailed March 31, 2006 does not place the application in condition for allowance.

Applicant has amended the independent claims and also addresses that the "concave" limitation, namely, that the "communication device is concave to generally follow a contour of a user's face" is not described or suggested by the prior art cited.

B. Prior Art Rejections (35 U.S.C. §103)

Claims 1-2, 4-6, 8, and 10-12 were rejected under 35 U.S.C. §103 as being unpatentable over Japanese Patent Reference No. 2003-032342A to Oda Tetsuya (hereinafter referred to as "Oda"), in view of U.S. 5,485,504 to Ohnsorge (hereinafter referred to as "Ohnsorge").

Applicant has amended independent claims 1, 8 and 14 to recite that the wireless communication device further comprises a first and a second opening

defined proximate the second side surface, with the speaker situated within the housing to transmit acoustic signals via the first opening, and the microphone situated within the housing to receive acoustic signals via the second opening. Moreover, the claims now also recite that the second side surface is configured to be in contact with or proximate a user head and the first side is configured to be situated furthest from the user head during communication device use, with the second side surface adapted to increase the distance between user head and the antenna and reduce EM interference between the user head and the antenna.

Furthermore, Applicant submits that the independent claims 1, 8 and 14 each include, *inter alia*, the limitation that a communication device comprise "a housing including ... a second side surface being concave to generally follow a contour of a user's face."

Oda and Ohnsorge, alone or in combination, do not describe or suggest a communication or wireless device having a first and a second opening defined proximate the second side surface with a speaker situated via the first opening and the microphone situated via the second opening, where the second side surface is configured to be in contact or proximate to the user's head while the first side is configured to be situated furthest away from the user head and the antenna, where said second side surface is adapted to increase the distance between the user's head and the antenna and reduce electromagnetic EM interference between the user's head and the antenna.

The art cited also does not describe or suggest a second side surface being concave to follow the contour of a user's face, as recited in the amended independent claims.

As previously explained, for example, FIG. 2 of Ohnsorge shows that the front surface of radiotelephone instead of the side surface is not integrally flat. The front surface of Ohnsorge is clearly shown to include three distinct segments. Each segment may be considered as having approximately a flat plane, i.e., a first flat segment housing the speaker, a second segment holding the lens, the video display and keypad, and a third segment housing the microphone. Therefore, the three flat planes form the front surface in Ohnsorge's device in a U-shape like surface.

Therefore, Ohnsorge's configuration cannot be said to be "concave". According to the *Merriam-Webster* dictionary, a concave structure or surface is "hollowed or rounded inward like the inside of a bowl", "arched in, curving in, used of a side of a circle or surface on which neighboring normals to the curve or surface converge and on which lies the chord joining two neighboring points of the curve or surface." According to www.dictionary.com, a concave surface, structure or line is one which is "curved like the inner surface of a sphere."

In Applicant's case, the amended claims 1, 8 and 14 recite that the side surface of communication device is concave to follow the contour of a user's face and as an exemplary case, Fig. 3 of Applicant's Specification, shows the contour of the side surface is concave rather than having distinct flat segments, as shown Ohnsorge. Therefore, Ohnsorge does not disclose a concave surface or anything resembling a curved section of an inner surface of a sphere.

Also, a combination of three flat surfaces simply cannot be equated with a concave surface, both geometrically and practically speaking. There are significant differences which result from a surface having a U-shape like surface and having a concave surface. For instance, the fit of the device against a user's head is impaired

by having a U-shaped like surface rather than a concave one. A person's head may be oval, round, or generally circular and in order to obtain a proper and an appropriate and natural fit to a user's head, a device with a concave surface provides a more comfortable engagement and fit than a device having a surface like that shown in Ohnsorge. Because different users have different head sizes, a concave fit will undoubtedly fit better regardless of how the user may hold the device against his/her head (e.g., higher, or lower relative to one's head), whereas with a device having a U-shape like surface, a user is constrained by the rigid and sharp flat sections of the device. Further, manufacturing considerations would be affected as well as by having a concave surface rather than a U-shape like surface.

In addition, a person with skill in the art would not be motivated to combine the teachings of Ohnsorge with Oda's to arrive at Applicant's newly amended claims. The purpose in Oda is to make sure that the device does not come into contact with the face of a user (see Oda, Abstract), i.e., to provide a portable phone having a large sized display in a small size portable phone body, where the display would not be in contact with a user's face, keeping it clean and not becoming dirty due to the close proximity of a user's face with the device.

Ohnsorge, on the other hand, has a design with a U-shape like surface which would allow a user's face to come in closer contact with the display of the device. Thus, Ohnsorge would result in the very problem that Oda is aimed to solve. Therefore, one skilled in the art, knowing that Oda teaches that the side surface, and not the front surface should be proximate the user's head (ears and mouth) would not be motivated to use the U-shape like surface of Ohnsorge's phone design.

The Advisory Action states that the above line of reasoning argues against individual references. However, Applicant is arguing against the combination of these references, not their individual teachings. According to the MPEP, in analyzing 103 obviousness rejections, the claimed invention must be considered as a whole and the references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination (see MPEP 2141 discussion *re* Graham factual inquiries). The MPEP offer guidance on how to examine obviousness issues:

"There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art. *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a *prima facie* case of obvious was held improper.). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999)." (MPEP 2143.01)

Thus, to combine Oda and Ohnsorge, the motivation to combine must be either implicitly or explicitly provided in the reference themselves. If Oda proposes a solution to a particular problem, and Ohnsorge would be counter to this problem, then, the motivation to combine is lacking. Simply put, the nature of the problem to be solved in Oda as a whole does not motivate or suggest to a mobile handset designer that Oda's handset may be modified as recited in Applicant's claims. Thus, the combination of Oda and Ohnsorge's teachings is not desirable. In fact, the

proposed combination or modification would change the principle of operation of Oda's portable handset design. In other words, the primary reference relied upon, Oda, would have to be redesigned if it were to be combined with Ohnsorge, which means that the basic principle of operation that Oda was designed to operate would have to be changed. In other words, the principle of keeping the front surface area clean would be altered because the design of Oda must be modified based on Ohnsorge's design teachings.

Further, just the fact that the references can be combined or modified is not sufficient under the law to establish a prima facie obviousness showing. Nor is the fact that the claimed invention is within the capability of one of skill in the art, by itself, sufficient to show prima facie obviousness.

Moreover, none of the references, either Oda or Ohnsorge teaches or suggests that the second side surface is configured to be in contact with or proximate a user head and the first side is configured to be situated furthest from the user head during communication device use, with the second side surface adapted to increase the distance between user head and the antenna and reduce EM interference between the user head and the antenna.

The Examiner also rejected claims 3 and 9 under 35 U.S.C. §103 as being unpatentable over Oda in view of Ohnsorge as applied to claim 1, 8, and in further view of U.S. 2002/0160725A1 to Toyota (hereinafter referred to as "Toyoda"). The Examiner further rejected claims 14-19 as well as being unpatentable over Oda in view of Toyoda and Ohnsorge.

Since claims 3-6, 9-12, and 16-19 each include, *inter alia*, the limitations of the newly amended independent claims 1, 8, and 14, Applicant submits that the cited references do not teach or suggest all of these claim limitations.

Applicants submit that the claims now are allowable over the combination of the cited reference as none of the above references, alone or in combination, suggest or describe the aforementioned features recited in Applicant's claims. The limitations of pending claims 1, 3-6, 8-12, 14, 16-19 are not taught or suggested by the prior art cited, and these claims are now patentably distinct and in condition for allowance, which action is respectfully requested.

C. Conclusion

For all the foregoing reasons, allowance of all pending claims is respectfully requested. Payment of the RCE fee and the fee for a one-month extension of time under the provisions of 37 CFR 1.136(a) accompanies the present submission. No other fee is believed due. However, the Director is authorized to charge any additional fee(s) or any underpayment of fee(s) or credit any overpayment(s) to Deposit Account No. 50-3001 of Kyocera Wireless Corp.

Respectfully Submitted,

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